

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86282184
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86282184/large
LITERAL ELEMENT	SALESFIT
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	

Applicant hereby responds to the Office Action mailed on October 24, 2015.

LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration under Section 2(d) based on the allegation that there is a likelihood of confusion with Registration No. 4611216 for the mark SALESFITNESS for “Computer software in the nature of a mobile application for downloading, watching, storing, recordng and sharing digital content in the field of human resource development; downloadable mobile applications that allow users to record and share video content, form virtual communities, get feedback from their peers, participate in discussions and engage in social networking; computer programs for viewing pre-recorded digital content, namely, pre-recorded video; computer game software in the field of human resources that enables users to set and manage goals and to receive prizes or recognition if they achieve goals.”

For the reasons set forth below, Applicant respectfully submits that its mark is not likely to cause confusion, mistake or deception with the cited registration and requests that the refusal be withdrawn.

**A. There is No Basis to Conclude that the Goods and Services Identified by the Marks are Closely Related
and Travel in Similar Trade Channels**

The Applicant has amended its identification of services to clearly identify the limited scope of those services, i.e., sales tracking software for real estate professionals and educational services, namely, providing live and online training, educational instruction, classes, seminars and workshops in the field of real estate sales and marketing and distribution of materials in connection therewith. With these amendments, it is clear that Registrant’s goods are aimed at professionals in the human resources field who wish to share digital content with one another, form virtual communities, and play video games, while Applicant’s services comprise in-person and online classes for real estate professionals and software aimed real estate professionals who wish to track their sales.

The substantial differences between the respective services are such that confusion is clearly not likely. It is well settled that likelihood of confusion must be determined on the basis of the services and goods as they are set forth in the application and cited registration. See e.g., Paula Payne Products, Co. v. Johnson Publishing Co., 177 USPQ 76 (CCPA 1973); In re Chalet Chocolates, Inc., 212 USPQ 968 (TTAB 1982); Ferdinand Mulhens v. Sir Edward Ltd., 214 USPQ 298 (TTAB) 1981; Ziebart International Corp. v. Northern Instruments Corp., 212 USPQ 537 (TTAB 1981).

Where the services of the parties are different on their face, as they are here, it is necessary to show that the surrounding circumstances

or marketing conditions are such that they would be encountered by the same persons under circumstances that would give rise to the mistaken belief that they have a common source. In re American Hoechst Corp., 19 USPQ 947, 947 (TTAB 1983); UMC Industries, Inc. v. UMC Electronics Co., 207 USPQ 861, 879 (TTAB 1980); In re Whittaker Corp., 200 USPQ 54 (TTAB 1978); In re Mack, 197 USPQ 755, 756 (TTAB 1977); Mobay Chemical Co. v. The Standard Oil Co., 163 USPQ 230 (TTAB 1963). Respectfully, the Examining Attorney has not submitted any such evidence. This is especially true in connection with Applicant's Class 41, for which no mention is made at all in the likelihood of confusion rejection.

Moreover, in this case, the consumer of both Applicant's services, as well as those of the cited registration, is sophisticated. The services are not "impulse" purchases, but rather, are purchased based upon personal preferences by careful, consumers, who have researched the provider of the services. Applicant's services, in particular, are aimed at real estate professionals, not the common consumer. Real estate professionals looking to take in-person classes and track their real estate sales do not simply buy software they find with "sales" in the title, especially when that software is social media software for *human resources professionals* who would like to share content, join virtual communities, or play video games. There is no relationship between video game software and social media applications for human resources professionals and in person classes for real estate professionals. Instead, considerable and often lengthy consideration is given to the focus of the classes sought and the software sales tracking features offered. It would be unusual for members of one professional field looking for classes and tracking software to be confused by a social media application presented exclusively to members of a different professional field.

Indeed, the services offered under the cited mark are intended *solely* for human resources professionals. They are not offered nor geared towards the general public looking for software. Applicant's services are intended *solely* for real estate professionals. The sophisticated customers (i.e.: human resources professionals) interested in taking social medial software would not mistakenly believe Applicant's SALESFIT in-person classes and software aimed at real estate professionals wanting to track their sales would provide the sought functionality. Similarly, the sophisticated customers interested in taking in-person classes and tracking their real estate sales would not mistakenly believe a social media application for human resources professionals would provide the sought after information.

The court in Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (CAFC 1992) specifically indicated that it was "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimus* situations but with the practicalities of the commercial world, with which the trademark laws deal."

The sophisticated consumer would not be confused by a social media program for human resources professionals offered under the trademark SALESFITNESS and real estate in-person classes and sales tracker software for real estate professionals under the trademark SALESFIT. The practicalities of the commercial world at issue in this case, e.g., a sophisticated consumer facing trademarks with different commercial impressions offering different services, does not support a likelihood of confusion.

B. The Higher Standard for a Likelihood of Confusion between Applicant's Mark and the Cited Mark Has Not Been Met

In conclusion, in order to maintain a rejection under Section 2(d) it is not sufficient if confusion is merely "possible." A higher standard is required. See Shatel Corp. v. Mao Ta Lumber & Yacht Corp., 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient."). This burden has not been met in this case.

The statutes and regulations that govern issuance of trademark registrations permit any persons who believes they may be damaged by a registration to file an opposition. Other persons engaged in the relevant business would be in the best position to determine whether a mark poses a risk of damage. Thus, any doubt should be resolved in favor of Applicant, and this application should be passed to publication. See In re Grand Metropolitan Foodservice, Inc., 30 U.S.P.Q.2d 1974 (TTAB 1994); In re Geo. Weston Ltd., 228 U.S.P.Q. 57 (TTAB 1985); In re Geo. A. Hormel & Co., 218 U.S.P.Q. 286 (TTAB 1983); In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (TTAB 1972).

In view of the foregoing, it is respectfully requested that the refusal of registration be withdrawn and that this application be approved for publication in the *Official Gazette*.

GOODS AND/OR SERVICES SECTION (009)(current)

INTERNATIONAL CLASS	009
DESCRIPTION	

Computer software featuring information on real estate sales and marketing; Computer application software for mobile phones; Downloadable software in the nature of a mobile application; Downloadable multimedia files	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (009)(proposed)	
INTERNATIONAL CLASS	009
TRACKED TEXT DESCRIPTION	
Computer software featuring information on real estate sales and marketing; <u>Computer application software for mobile phones for use by real estate professionals to track real estate sales numbers;</u> Computer application software for mobile phones; <u>Downloadable software in the nature of a mobile application for use by real estate professionals to track real estate sales numbers;</u> Downloadable software in the nature of a mobile application; Downloadable multimedia files	
FINAL DESCRIPTION	
Computer application software for mobile phones for use by real estate professionals to track real estate sales numbers; Downloadable software in the nature of a mobile application for use by real estate professionals to track real estate sales numbers	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (041)(no change)	
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Marjorie Witter Norman/
SIGNATORY'S NAME	Marjorie Witter Norman
SIGNATORY'S POSITION	Associate Attorney, Venable LLP, California Bar Member
SIGNATORY'S PHONE NUMBER	310.229.0468
DATE SIGNED	04/25/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Apr 25 19:08:09 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.X.XXX.XXX-2 0160425190809054306-86282 184-550afa7a0e88967f02c2e f5f8226020fbd7e170f251c58 37e36881f57ebf822474a-N/A -N/A-20160425185902802404

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86282184** SALESFIT(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86282184/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

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For the reasons set forth below, Applicant respectfully submits that its mark is not likely to cause confusion, mistake or deception with the cited registration and requests that the refusal be withdrawn.

A. There is No Basis to Conclude that the Goods and Services Identified by the Marks are Closely Related and Travel in Similar Trade Channels

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In view of the foregoing, it is respectfully requested that the refusal of registration be withdrawn and that this application be approved for publication in the *Official Gazette*.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for Computer software featuring information on real estate sales and marketing; Computer application software for mobile phones; Downloadable software in the nature of a mobile application; Downloadable multimedia files

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Computer software featuring information on real estate sales and marketing; Computer application software for mobile phones for use by real estate professionals to track real estate sales numbers; Computer application software for mobile phones; Downloadable software in the nature of a mobile application for use by real estate professionals to track real estate sales numbers; Downloadable software in the nature of a mobile application; Downloadable multimedia files~~

Class 009 for Computer application software for mobile phones for use by real estate professionals to track real estate sales numbers; Downloadable software in the nature of a mobile application for use by real estate professionals to track real estate sales numbers

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the

mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Marjorie Witter Norman/ Date: 04/25/2016

Signatory's Name: Marjorie Witter Norman

Signatory's Position: Associate Attorney, Venable LLP, California Bar Member

Signatory's Phone Number: 310.229.0468

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86282184

Internet Transmission Date: Mon Apr 25 19:08:09 EDT 2016

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